

REMARKS

Claims 2-7, 9-30 are presented for examination. Claims 2, 3, 4, 5, 6, 7, 9, 14, 17, 19, 20, 21, 23, 24, 28, and 29 are independent.

The Examiner indicated that the Information Disclosure Statement (IDS) filed on February 2, 2004 has not been considered because it does not include a concise explanation of the relevance.

It is respectfully submitted that the Examiner's position is not proper because the IDS was filed with a translation of the corresponding Japanese Office Action that discusses the relevance of the reference. Therefore, consideration of the IDS is respectfully requested.

Further, the Examiner has raised some claim objections in paragraph 2 of the Office Action. Claims 2, 4 and 11 have been amended to address these objections. However, no word "server" is found in claim 6.

Claims 14-16, 23-24 and 28-29 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Salmivalli. This rejection is respectfully traversed for the following reasons.

Anticipation, under 35 U.S.C. § 102, requires that each element of a claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1920 (Fed. Cir. 1989) *cert. denied*, 110 S.Ct. 154 (1989). The term "anticipation," in the sense of 35 U.S.C. 102, has acquired the accepted definition meaning "the disclosure in the prior art of a thing substantially identical with the claimed invention." *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978). The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir.

1984). To satisfy this burden, therefore, each and every element of the claimed invention must be shown by the Examiner to be disclosed in Salmivalli.

Each of the independent claims 14, 23, 24, 28 and 29 recites counting for every group of terminal devices, and providing information based on a result of the counting. The Examiner relies upon col. 4, lines 59-61, of Salmivalli for disclosing counting for each group.

Considering the reference, Salmivalli discloses counters for counting the number of registered mobile subscribers for each subscriber group. However, this information is used for controlling registration. Salmivalli does not disclose providing the counting result to terminal devices or participants of the network, as the claims 14, 23, 24, 28 and 29 require.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that the Salmivalli teaching of controlling registration **necessarily** includes providing the counting result to terminal devices or participants of the network, as the claims 14, 23, 24, 28 and 29 require.

Moreover, one skilled in the art would recognize that it is not necessary to provide the result of counting of the number of registered mobile subscribers to terminal devices or participants of the network in order to control registration.

Accordingly, it cannot be said that Salmivalli describes the claimed invention within the meaning of 35 U.S.C. § 102. *Kalman v. Kimberly-Clark Corp.*, *supra*. Applicants, therefore, respectfully submit that the rejection of claims 14-16, 23-24 and 28-29 under 35 U.S.C. § 102 as anticipated by Salmivalli is untenable and should be withdrawn.

Claims 2-7, 9-13, 17-20, 25-27 and 30 have been rejected under 35 U.S.C. § 103 as being unpatentable over Troxel in view of Morita. This rejection is respectfully traversed for the following reasons.

First, it is respectfully submitted that the rejection of claim 30 is improper. This claim depends from claim 29, and therefore incorporates all limitations of claim 29. However, neither Troxel nor Morita is applied by the Examiner with respect to claim 29. Therefore, the Examiner admits that these references do not disclose the subject matter of claim 29. Accordingly, they cannot disclose the subject matter of claim 30 dependent from claim 29.

Further, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). These showings by the Examiner are an essential part of complying with the burden of

presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Examiner has failed to provide the requisite reasons for modifying the Troxel reference and thus to establish a *prima facie* case of obviousness.

In particular, the Examiner admits that Troxel does not disclose the counter and the voice providing means or steps for providing voice data corresponding to the counted value, as independent claims 2, 4, 5, 6, 7, 9, 17, 19, and 20 recite. The Examiner relies upon Morita for disclosing the counter and the voice providing means.

Considering the reference, Morita discloses controlling audio device in accordance with a counter value to gradually decrease or increase the audio volume when the counter counts down or up.

By contrast, Troxel discloses a network administrator that grants or denies log-in requests from clients depending on the number of requests. Troxel suggests a counter incremented at the time a client computer logs into the host computer system to limit the number of concurrent users.

The Examiner takes the position that it would have been obvious “to have utilized the counter to control audio/voice information/volume output of Morita in the process of providing information in Troxel.” The Examiner repeats this statement on pages 7, 9, 10, 11, 12, 13 of the Office Action.

It is respectfully submitted that if the Troxel were modified in the manner suggested by Morita, the Troxel system would reduce or increase the audio volume of sound signals transmitted to clients depending on the number of log-in requests.

However, Troxel does not suggest transmitting any sound signals to the clients. Therefore, it does not need to modify the volume of these signals in the manner suggested by Morita.

Moreover, it is respectfully submitted that no person skilled in the art of data networks would suggest transmitting over the Troxel network a sound signal with a volume controlled to represent the number of log-in requests.

It is noted that Troxel stresses that the invention may be implemented on a conventional computer system (col. 3, lines 52-53). However, the sound transmission system suggested by the Examiner cannot be implemented on a conventional computer system. Therefore, the modification proposed by the Examiner would render the Troxel invention being modified unsatisfactory for its intended purpose, i.e., performing client access management in a conventional computer system.

However, it is well settled that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, there is no suggestion or motivation to modify the Troxel system in the manner suggested by the Examiner.

Therefore, Applicants submit that the lack of any motivation for the proposed combination of references to arrive at the claimed invention undermines the basis for the Examiner's rejection under 35 U.S.C. § 103.

In addition, it is respectfully submitted that even if the references were combined, the claimed inventions would not result.

In particular, the combined teachings would not teach or suggest means or steps for providing information in accordance with the counter value in the manner required in independent claims 2, 4-7, 9, 17, 19 and 20.

Further, the combined teaching would not suggest separate counting for different groups of terminal devices, and providing information corresponding to the count value for every group, as claim 3 requires.

Applicants, therefore, respectfully submit that the rejection of claims 2-7, 9-13, 17-20, 25-27 and 30 under 35 U.S.C. § 103 as being unpatentable over Troxel in view of Morita is improper and should be withdrawn.

Claims 21-22 have been rejected under 35 U.S.C. § 103 as being unpatentable over Salmivalli in view of Morita. This rejection is respectfully traversed for the following reasons.

Independent claim 21 recites a server device which can communicate with terminal devices through a network. The server device includes a memory for storing a program, a processor for executing the program, and a communications device for sending and receiving information to and from said terminal devices.

The claim specifies that:

- the communications device receives predetermined input information sent from said terminal devices that are divided into groups beforehand, through the network,
- the processor counts for every group, in accordance with the input information received by the communications device,
- the processor generates for every group, information including voice information corresponding to the counted value, and
- the server device sends the generated information to said terminal devices from the communications device through the network.

The Examiner holds Salmivalli to differ from the claimed invention only in that the reference does not disclose generating voice information corresponding to the counted value. Morita is relied upon for disclosing this feature.

First, as discussed above, Salmivalli does not disclose sending the information corresponding to the counted value to the terminal devices. Therefore, this reference cannot disclose the server device that sends the generated information to the terminal devices from the communications device through the network as claim 21 requires.

Further, the Examiner has failed to provide the requisite reasons for modifying the Salmivalli reference and thus to establish a *prima facie* case of obviousness.

In particular, the Examiner takes the position that it would have been obvious “to have utilized the counter to control audio/voice information/volume output of Morita in the process of providing information in Salmivalli.”

As discussed above, Salmivalli discloses counters for counting the number of registered mobile subscribers for each subscriber group.

Similarly to Troxel discussed above, Salmivalli does not suggest transmitting any sound signals to the subscribers. Therefore, it does not need to modify the volume of these signals in the manner suggested by Morita.

Moreover, no person skilled in the art of mobile communication systems would suggest transmitting over the Salmivalli system a sound signal with a volume controlled to represent the number of registered subscribers.

Salmivalli indicates that the invention may be implemented in connection with any mobile communication system (col. 3, lines 65-66). However, the sound transmission system suggested by the Examiner cannot be implemented using a conventional mobile communication system. Therefore, the modification proposed by the Examiner would render the Salmivalli invention being modified unsatisfactory for its intended purpose, i.e., performing subscriber access management in a conventional mobile communication system.

As proposed modification would render the Salmivalli invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to modify the Salmivalli system in the manner suggested by the Examiner. *In re Gordon, supra.*

Accordingly, Applicants submit that the lack of any motivation for the proposed combination of references to arrive at the claimed invention, coupled with the absence of a teaching or suggestion in the references of details recited in the claims, undermine the basis for the Examiner's rejection under 35 U.S.C. § 103.

Applicants, therefore, respectfully request that the rejection of claims 21-22 under 35 U.S.C. § 103 as being unpatentable over Salmivalli in view of Morita is improper and should be withdrawn.

CONCLUSION

As demonstrated above, the Examiner has failed to establish *prima facie* cases of anticipation and obviousness under 35 U.S.C. § 102 and 35 U.S.C. § 103. Therefore, claims 2-7, 9-30 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.


Entry of the amendments of claims under 37 CFR § 1.116 is respectfully requested because the amendments comply with requirements of form expressly set forth in the previous Office Action.

09/666,086

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: August 19, 2004